

PRELIMINARY REMARKS

Claims 11 to 22 as set forth in Appendix II of this paper are now pending in this case. Claims 1, 9 and 10 have been canceled, and Claims 11 to 22 have been added as indicated in Appendix I of this paper.

New Claims 11 to 20 are supported by Claim 1 and by applicants' disclosure on page 5, indicated line 14, to page 6, indicated line 4, of the application. New Claims 21 and 22 essentially correspond to Claims 9 and 10. No new matter has been added.

The Examiner has suggested to delete the wording "synergistically effective amount" in favor of the phrase -effective amount-. Applicants have not adapted the wording suggested by the Examiner because a claim revised accordingly is not deemed to define what applicants regard as the invention. The requirement that the active components (a) and (b) are present in synergistically effective amounts is deemed to be an essential feature of the claimed subject matter and the revision suggested by the Examiner would remove that essential requirement. Favorable reconsideration of the Examiner's position is therefore solicited.

Applicants respectfully urge that the Examiner's reasons for rejecting Claims 1, 9 and 10 are not applicable to the new claims herewith submitted for the following reasons.

Claims 1, 9 and 10 were rejected under Section 103(a) as being unpatentable in light of the teaching of *Schwalge et al.* (US 5,972,941) and *Kasahara et al.* (US 5,847,005). In her rejection, the Examiner asserted that applicants' mixture of the active components (a) and (b) exhibited no more than additive effects. However, applicants' independent claim expressly requires that the active components are present in synergistically effective amounts. The Examiner disregarded the express limitation pointing to her reasons for finding the the respective limitation insufficiently enabled by applicants' disclosure.

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art, and all words in a claim must be considered in judging the patent-

ability of that claim against the prior art regardless of whether they raise an issue under Section 112, ¶1¹). The Examiner's disregard in the evaluation under Section 103(a) of applicants' express limitation in the claims that the active components (a) and (b) of the mixture be present in synergistically effective amounts therefore constitutes error. For the foregoing reasons and the arguments presented by applicants in the earlier proceedings, new Claims 11 to 22 cannot be regarded as unpatentable within the meaning of Section 103(a) in light of the teaching of *Schwalge et al.* (US 5,972,941) and *Kasahara et al.* (US 5,847,005). It is also noted in this context that the Examiner's finding that applicants tests employ merely one representative of formula (II) is incorrect. The compounds employed in the exemplifications set forth on pages 15 to 17 of the application and in the tests reported in Dr. Ammermann's Declaration differ in the nature of the radical represented by "X¹" in formula (II), and the tests corroborate that compounds carrying a haloalkyl group and compounds carrying a haloalkoxy group in the respective position are analogs with regard to the synergistic effect arising from a combination with a morpholine or piperidine compound (I).

In the rejection of Claims 1, 9 and 10 under Section 112, ¶1, the Examiner asserted that applicants' disclosure was insufficient to properly enable a person of ordinary skill to make and/or use the claimed invention commensurate in scope with the claims. The Examiner contended that a person of ordinary skill would need to engage in more than routine experimentation in order to determine the the specific representatives of the active components which provide for a combination exhibiting synergistic fungicidal properties. In accordance with the new claims as herewith submitted the scope of formula (II) has been adapted to closely resemble the compounds employed in the representative examples. The Examiner's reasons for the rejection of Claims 1, 9 and 10 under Section 112, ¶1, are therefore not deemed applicable to the new claims.

Favorable action is solicited in light of the foregoing and the attached.

1). *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970); note also *Ex parte Grasselli*, 231 USPQ 393 (POBA 1983)

REQUEST FOR EXTENSION OF TIME:

It is respectfully requested that a two month extension of time be granted in this case. A check for the \$410.00 fee is attached.

Please charge any shortage in fees due in connection with the filing of this paper, including Extension of Time fees to Deposit Account No. 11.0345. Please credit any excess fees to such deposit account.

Respectfully submitted,

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Encl.: THE CHANGES IN THE CLAIMS (Appendix I)
THE AMENDED CLAIMS (Appendix II)

HBK/BAS

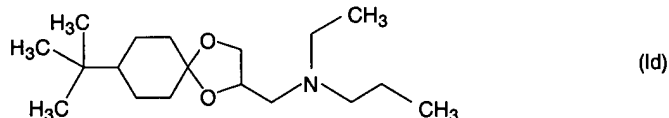
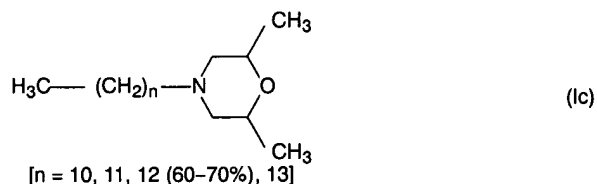
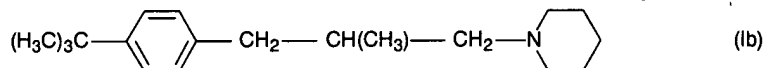
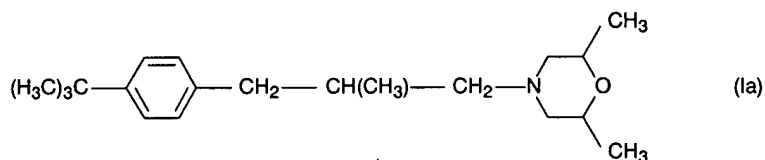
A P P E N D I X I:

THE CHANGES IN THE CLAIMS (version with markings, showing the changes made):

Claims 1, 9 and 10 have been canceled, new Claims 11 to 22 have been added as follows:

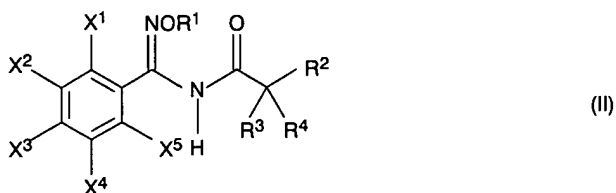
11. (new) A fungicidal mixture, comprising as active components

a) a morpholine or piperidine compound I selected from the group of compounds Ia, Ib, Ic and Id



and

b) a compound of formula II



wherein

X¹ is C₁-C₄-haloalkyl or C₁-C₄-haloalkoxy;

X² is hydrogen or C₁-C₄-alkyl;

X³ is hydrogen or C₁-C₄-alkyl;

X⁴ is halogen;

X⁵ is halogen;

R¹ is methylenecyclopropyl, methylenecyclopentyl, methylenecyclohexyl or methylenecyclohexenyl;

R² is phenyl which is optionally substituted by halogen, C₁-C₄-alkoxy or C₁-C₄-alkyl;

R³ and R⁴ are, independently of one another, hydrogen or C₁-C₄-alkyl;

in a synergistically effective amount.

12. (new) The mixture defined in claim 11, wherein R¹ is methylenecyclopropyl. ✓
13. (new) The mixture defined in claim 11, wherein R² is phenyl. ✓
14. (new) The mixture defined in claim 11, wherein R³ or R⁴ is hydrogen. ✓
15. (new) The mixture defined in claim 11, wherein R³ and R⁴ are hydrogen.
16. (new) The mixture defined in claim 11, wherein X² or X³ is hydrogen. ✓
17. (new) The mixture defined in claim 11, wherein X² and X³ are hydrogen.
18. (new) The mixture defined in claim 11, wherein X⁴ is chlorine or fluorine. ✓
19. (new) The mixture defined in claim 11, wherein X⁵ is chlorine or fluorine. ✓
20. (new) The mixture defined in claim 11, wherein
X² is hydrogen; ✓
X³ is hydrogen;
R¹ is methylenecyclopropyl;
R² is phenyl; and
R³ and R⁴ are hydrogen.
21. (new) The mixture defined in claim 11, which is conditioned in two parts, wherein one part comprises one or more compounds I in a solid or liquid carrier and the other part comprises one or more compounds of the formula II in a solid or liquid carrier.
22. (new) A method for controlling harmful fungi, which comprises treating the fungi, their habitat or the materials, plants, seeds, soils, areas or spaces to be protected against fungal attack with the mixture defined in claim 11, where the compounds I

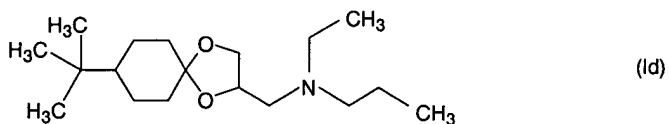
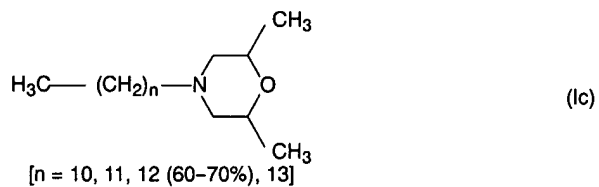
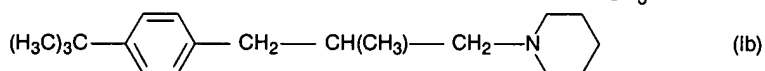
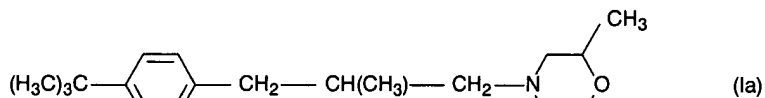
and one or more compounds of formula II are applied simultaneously, that is either together or separately, or successively.

APPENDIX II:

THE AMENDED CLAIMS (clean version of all claims):

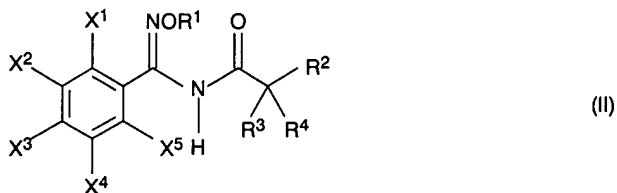
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 11. (new) A fungicidal mixture, comprising as active components

- a) a morpholine or piperidine compound I selected from the group of compounds Ia, Ib, Ic and Id



and

- b) a compound of formula II



wherein

X¹ is C₁-C₄-haloalkyl or C₁-C₄-haloalkoxy;

X² is hydrogen or C₁-C₄-alkyl;

X³ is hydrogen or C₁-C₄-alkyl;

X⁴ is halogen;

X⁵ is halogen;

R¹ is methylenecyclopropyl, methylenecyclopentyl, methylenecyclohexyl or methylenecyclohexenyl;

R² is phenyl which is optionally substituted by halogen, C₁-C₄-alkoxy or C₁-C₄-alkyl;

R³ and R⁴ are, independently of one another, hydrogen or C₁-C₄-alkyl;

in a synergistically effective amount.

12. (new) The mixture defined in claim ¹²11, wherein R¹ is methylenecyclopropyl.
13. (new) The mixture defined in claim ¹²11, wherein R² is phenyl.
14. (new) The mixture defined in claim ¹²11, wherein R³ or R⁴ is hydrogen.
15. (new) The mixture defined in claim ¹²11, wherein R³ and R⁴ are hydrogen.
16. (new) The mixture defined in claim ¹²11, wherein X² or X³ is hydrogen.
17. (new) The mixture defined in claim ¹²11, wherein X² and X³ are hydrogen.
18. (new) The mixture defined in claim ¹²11, wherein X⁴ is chlorine or fluorine.
19. (new) The mixture defined in claim ¹²11, wherein X⁵ is chlorine or fluorine.
20. (new) The mixture defined in claim ¹²11, wherein
X² is hydrogen;
X³ is hydrogen;
R¹ is methylenecyclopropyl;
R² is phenyl; and
R³ and R⁴ are hydrogen.
21. (new) The mixture defined in claim ¹²11, which is conditioned in two parts, wherein one part comprises one or more compounds I in a solid or liquid carrier and the other part comprises one or more compounds of the formula II in a solid or liquid carrier.
22. (new) A method for controlling harmful fungi, which comprises treating the fungi, their habitat or the materials, plants, seeds, soils, areas or spaces to be protected against fungal attack with the mixture defined in claim ¹²11, where the compounds I and one or more compounds of formula II are applied simultaneously, that is either together or separately, or successively.